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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,561	03/04/2002	Basil Naji	BALDS2.024AUS	5549

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EXAMINER	
MARCANTONI, PAUL D	
ART UNIT	**PAPER NUMBER**
1755	

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/090,561	NAJI ET AL.	
	Examiner	Art Unit	
	Paul Marcantoni	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 April 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9,12 and 16-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9,12 and 16-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The applicants' reply of 4/6/06 has been considered but is not persuasive and the applicants' amendment necessitated the new grounds of rejection below:

New Matter:

Claims 1-9,12, and 16-19 are rejected under 35 USC 112 first paragraph and 35 USC 132 as the specification as originally filed would not appear to provide support for the now claimed invention.

The new claim "dewatering occurs in at least about 120 seconds" would appear to find no literal support in the applicants' specification and is new matter. The same would appear the situation for the other new claims. Should applicants show specific location of support for these claims, this new matter rejection will be promptly withdrawn.

35 USC 103:

Claims 1-9,12, and 16-19 are rejected under 35 USC 103(a) as being unpatentable over JP 60191074 (abstract Matsushita), Brothers et al. '921, or Liskowitz et al. (WO 97/21640 which is PCT/US96/19936).

Response:

The applicants argue that none of the references provide a coating for covering a building material. The examiner disagrees and notes that both concrete and mortar (especially mortar which is applied by troweling or even spraying) can still be coatings. Mortars are coatings well known in the art.

The applicants argue Matsushita and teach there is no teaching of a coating. Yet, the applicant's own coating becomes an inorganic hardened body upon setting and

curing. Also, it is notoriously known in the art that concrete and mortars can be a "coating".It is also noted that a review of applicants claims shows that there is no "method of coating" but only a method of making a coating which requires mixing two specific particle size ranges of fly ash and hydraulic binder of which no particular one is specified in the independent claims such as claim 1. The applicant's independent claims merely read upon mixing fly ash and hydraulic cement which is old in the art. It is also noted that it is unclear how applicants can even make a coating without "water" because not one independent claim comprises the very ingredient required to make their coating hydraulic and be able to set. Water is a critical component and is nowhere to be found in any independent claim. The applicants also provide no critical range of amounts of components (they are not even claiming water so the amounts of it are also thus missing) and it is unclear just how much fly ash and cement make up the total composition. The only thing one can be sure of is that applicants claim two particle size ranges of up to 100 microns for fly ash.

The applicants have also not shown how their use of two allegedly different size fly ash sizes leads to any criticality or unexpected result. Further, the second portion of fly ash still reads upon the first portion of fly ash so how do you distinguish between the two portions. If the second portion must be 100 microns or less and the first portion is 10 microns or less, it is clear that there is an overlap between the two fly ash portions and it is unclear how applicants distinguish between the two. Cannot the second fly ash portion also contain particle size ranges the same as the first portion? There is no restriction that the second portion must be greater than 10 microns so there is clear

overlap. The applicants' fly ash particle size ranges thus read from up to about 100 microns.

The applicants are not actually claiming a method of coating and there is no positive recitation of coating steps but only that it could be applied as a coating (ie "such that application of a slurry of said formulation to said first surface....)

The Applicants argument of expectation of success for Matushita is not understood because it is old in the art to use cement/concrete/mortars as coatings and it is routinely and conventionally done in the art.

The applicants argue Brothers and appear to allege that it is not coating a building product. In rebuttal, applicants are not claiming a method of coating but only a method of making a composition of fly ash and cement (no water claimed) used to coat a building product (applicants do not specify what exactly they mean by that either so the term can be given its broadest meaning). Applicants cannot read into their term simply a "building board" or "floor underlayment" if that is what they mean by "building material because that is not was they claim. Brothers teaches a coating on a building product, in this case the coating of cement, fly ash, and water is on the surface of a wellbore for oil well drilling and cement is poured into the wellbore and coats the sidewalls the structural integrity of the wellbore system. The applicants argue other components added in Brothers such as foam stabilizers. However, applicants are themselves using "comprising" claim language which allows for the inclusion of these components.

The applicants also argue Liskowitz does not apply because he does not teach a coating formulation for coating a building product. The examiner disagrees and notes this assertion is false. Liskowitz teaches a mortar can be made of his mixture of fly ash, cement, and water and mortars are notoriously known in the art as coatings for building materials (and buildings themselves) and are conventionally applied by troweling, spraying, brushing, etc. It is also noted that Liskowitz meets applicants' limitation for claim 4 because it teaches the addition of silica fume (see lines 1-15 on page 18 of Liskowitz) and that there is motivation to add silica fume (reads on silica flour) because it enhances the early rate of strength gain of a hardenable mixture and would thus be a desirable additive to the mortar (ie coating) composition or formulation. It is also noted that for Liskowitz and all the cited references above, that fly ash taken from a coal power plant as waste material does contain cenospheres and thus would meet the limitations of applicants' claim 4 as well.

Prior Art That Could Also have been used against Applicant's Claims:

Cornwell et al. (US Patent No. 4,088,804) teach a cementitious coating which contains Portland cement, fly ash, pigments, finely divided silica (reads upon silica flour) and aluminum trihydrate (see claims).

Massey (US Patent No. 4,441,944) teaches a coating composition for a building material such as building boards that contains Portland cement, fly ash optionally containing cenospheres, water, and fibers.

The following references were previously cited and all teach "mortars" which are notoriously known in the art as coating materials:

JP 55130847 teaches composition of cement, fly ash, and water for a plastering mortar. Plastering mortar coats a building material surface (see abstract).

Brook et al. (US Patent No. 5,556,458 teaches in Example 5, for example a composition comprising class C fly ash, Portland cement, and silica fume that meets applicants' claim limitations. Note again it teaches a grout or mortar which are coatings.

Wills Jr (US Patent No. 4,268,316) teaches a composition comprising cement and fly ash for masonry cement mortar or grouts (both coatings) and also meets applicants' claim limitations.

Francis et al. (US Patent No. 5,439,518) teaches a composition comprising fly ash, gypsum (hydraulic binder), and water and teaches fly ash in the range of 1 to 100 microns (col.3, lines 4-5).

Kirkpatrick et al. (US Patent Nos. 5,490,889 and 5,387,283) teach compositions which can be used for mortars (coating) comprising fly ash and cement.

Minnick also US Patent 2,987,408 also teaches a mixture of fly ash and cement and water useful as a coating. Minnick even teaches that fly ash resulting from combustion of pulverized coal is a heterogenous mixture of different size particles from large black cake like particles to almost transparent submicron glassy beads (ie "fly ash cenospheres"). Thus, Minnick teaches fly ash cenospheres are naturally present in fly ash (see col.5, lines 29-41).

Note: Applicants did not disclose this patent as part of the patents pertinent to the instantly claimed invention and should have been presented to the examiner. Nevertheless, the applicants are the same (Naji et al) and it would appear relevant:

Obviousness Type Double Patenting Rejection:

Claims 1-9,12, and 16-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims1-21 of U.S. Patent No. ***6,749,897 (Naji et al.).*** Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach making a coating composition using the same components of fly ash and hydraulic cement as well as other components such as alumina trihydrate (see claims)

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The finality of this office action is now proper. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Marcantoni
Primary Examiner
Art Unit 1755